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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRINH, TAN H

ART UNIT	PAPER NUMBER
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2684

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DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,939

Applicant(s)

BHATIA ET AL.

Examiner

TAN TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 11-14, 16, 20, 22-25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Barker (U.S. Patent No. 6,505,046).

Regarding to claim 11. Barker teaches a method for sending real-time information to a Business-to-Business (B2B) engine (see figs. 3, 4, 5,), the real-time information being related to a mobile telecommunications device within a telecommunications system, the method comprising the steps of- gathering, by the mobile telecommunications device; forwarding, after the step of gathering on real-time information to B2B engine (see figs. 5, 6 and 7, col. 1 lines 37-55 and col. 2 lines 8-27) and receiving a service unsolicited by the mobile telecommunication

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device from the B2B engine based on real-time information (see figs 6 and 7, col. 1 lines 37-55, col. 2 lines 8-27 and col. 8 lines 43-65).

Regarding to claim 12, Barker teaches the constructing from a plurality of the real-time information gathered during the gathering step, and forwarded a message to the B2B engine in the forwarding step (see col. 1, lines 38-55).

Regarding to claim 13, Barker teaches wherein the message is a short message service (SMS) message (see fig. 6 and 7 for SMS and col. 1 line 47).

Regarding to claim 14, Barker teaches the receiving a triggering event that initiates the gathering of the real-time information (see fig. 5, and col. 7, lines 43-51).

Regarding to claim 16, Barker teaches an application unit within the telecommunications device performs the gathering of the real-time information (see col. 8, lines 58-65).

Regarding to claims 20 and 25, Barker teaches wherein the real-time information indicates the location of the wireless communications device within the mobile telecommunications network (see col. 7, lines 16-28).

Regarding to claim 22, Barker teaches the system for facilitating information inter-exchange between a telecommunications network and an information service provider (see fig.

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3) the system comprising: the mobile telecommunications device is transmitting a real-time information to Business-to-Business (B2B) engine (see figs. 4 and 5), the B2B engine receiving the real-time information; and the B2B engine providing the real-time information to the information service provider (see figs. 6 and 7 and col. 2, lines 52-65, in response to the receipt of the real-time information, providing a service to the mobile telecommunications device (see figs. 2-7 and col. 1 lines 37-55 and col. 2, lines 52-65).

Regarding to claim 23. Barker teaches the real-time information is transmitted by the mobile telecommunications device and upon occurrence of an event (see fig. 5, and col. 7, lines 43-51).

Regarding to claim 24, Barker teaches the event is selected from the group consisting of: a power on/off update, a location area change update, and a periodic update (see col. 4, lines 43-52).

Regarding to claim 28, Barker teaches the mobile telecommunications device further comprises an application unit (see fig. 3, col. 6, lines 1-5), the application unit gathering the real-time information and constructing the real-time information gathered into a message that is transmitted to the B2B engine (see col. 26-37 and col. 6, lines 19-22)

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 17-19, 21, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (U.S. Patent No. 5,915,225) in view of Barker (U.S. Patent No. 6,505,046).

Regarding to claim 1, Mill teaches a telecommunications system in communication with a Business-to-Business (B2B) engine (see fig. 2 the PLMN 50 is a B2B engine), the mobile telecommunications device comprising: a SIM card (see figs. 3 and 5, SIM card 90); an application unit in communication with SIM card, the application unit gathering real-time information related to the mobile telecommunications device; and the application unit is forwarding the real-time information to the B2B engine (see col. 2 lines 6-29). But Mills fails to teach for the receiving a service unsolicited by the mobile telecommunications device from B2B engine base on the real time information.

However, Barker teaches the system process and enables a retail establishment or restaurant to advertise in real-time to local consumers. This is accomplished by transmitting coupons or advertisements to wireless subscribers (see col. 1 lines 37-55 and col. 2 lines 8-27 and figs 6 and 7, col. 8 lines 43-65).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify the Mill system and by providing of the teaching of Barker with in the real-time to local consumers for distribution retail coupons and advertisements thereto in order to provide user with the update information on advertises and convenience on real-time

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Consumer.

Regarding to claims 2 and 18, Mill teaches the mobile telecommunications device is initiating upon occurrence of an event, communication with the SIM card (see col. 3 lines 16-49).

Regarding to claims 3 and 19, Barker teaches the event is selected from the group consisting of: a power on/off update, a location area change update, and a periodic update (see col. 4, lines 43-52).

Regarding to claim 4, the mobile telecommunications device wherein the SIM card is a proactive SIM card. This is obvious with any SIM card and the SIM card can store data information and can retrieve the data, so that can be the proactive SIM card.

Regarding to claim 5, Mill teaches the forwarding the extracted data fetching the real-time information from the application unit (see col. 6, lines 7-16).

Regarding to claim 6, Mill teaches the SIM card further comprises triggering for triggering the application unit to construct a message containing the gathered real-time information (see fig. 3, col. 6 lines 16-27).

Regarding to claim 7, Mill teaches the application unit gathers the real-time information from the SIM card (see fig. 3, col. 6 lines 16-20).

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Regarding to claim 8, Mill teaches the mobile telecommunications device is selected from the group consisting of: a mobile station, a personal data assistant (PDA) device, and a wireless computing device (see fig. 2, and col. 1, lines 12-30).

Regarding to claim 9, Mill teaches the application unit resides on the SIM card (see fig. 5, app unit 150, and col. 2 lines 15-19).

Regarding to claim 10, Mill teaches the forwarding is in communication with the SIM card, the SIM card receiving the gathered information from the application unit and supplying the real-time information to the forwarding (see col. 6 lines 16-20).

Regarding to claim 17, Mills teaches the step of forwarding the real-time information is performed by a transmitting unit, the transmitting unit being in communication with a SIM card, and the SIM card being in communication with the application unit (see fig. 3, and col. 6 lines 12-20).

Regarding to claims 21 and 26, Mill teaches the mobile telecommunications device is selected from the group consisting of: a mobile station, a personal data assistant (PDA) device, and a wireless computing device (see fig. 2, and col. 1, lines 12-30).

Regarding to claim 27. Mill teaches the mobile telecommunications device further includes a memory card (see fig. 3 and 5 with item 90, and col. 4 lines 56-59).

Response to Arguments

5. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baker (U.S. Patent No. 6,505,046) discloses method and apparatus for distributing location-bases messages in a wireless communication network.

Mills (U.S. Patent No. 5,915,225) discloses remotely retrieving SIM stored data over a connections link.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)


*Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (703) 305-5622. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung, can be reached at (703) 308-7745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

Tan H. Trinh
Art Unit 2684
July 22, 2003


NGUYEN T. VO
PRIMARY EXAMINER